

Applic. No. 10/010,246
Response Dated March 7, 2005
Responsive to Office Action of January 5, 2005

Remarks:

Claims 1 to 10 and 17, 18, and 21 to 31 remain in the application. Claims 11 to 16 and 19 to 20 were canceled in a previous amendment to facilitate prosecution of the instant application.

In items 1 to 4 on pages 2 to 3 of the above-identified Office action, claims 1, 2, 4, 5, 7, and 21 to 26 have been rejected as being fully anticipated by U.S. Patent No. 5,575,802 to McQuilkin et al. (hereinafter "McQuilkin") under 35 U.S.C. § 102(b).

As will be explained below, it is believed that these claims were patentable over McQuilkin in their original form and, therefore, the claims have not been amended to overcome McQuilkin.

Claim 1 calls for, *inter alia*, a surgical clip, including:

a bridge connecting first and second arms to form a substantially U-shaped structure; and

at least one deformable retainer extending past one end of the arms in a direction, wherein the retainer has a length

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in the direction of at least approximately n times the distance between the arms when the arms are substantially parallel.

Claim 21 calls for, *inter alia*, a surgical clip, including:

a bridge connecting the first and second arms to form a substantially U-shaped structure with the first and second arms being substantially parallel to one another; and

at least one deformable retainer extending past one end of the arms in a direction, the retainer having a length in the direction equal to a multiple of a distance between the arms, the multiple being greater than 2.5.

Claim 22 calls for, *inter alia*, a surgical clip, including:

a bridge connecting first and second arms to form a substantially U-shaped structure.

Simply put, claims 1, 21, and 22 provide that "a bridge connect[s] said first and second arms to form a substantially U-shaped structure." By definition, a "U-shaped structure" requires some positive distance between the two arms of the U-

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shape. If there is no distance, then it cannot be considered U-shaped. When the two jaws 12, 14 are parallel, McQuilkin has no separation distance therebetween. Therefore, the McQuilkin clip cannot be considered U-shaped and, accordingly, cannot anticipate claims 1, 21, or 22.

To make up for the clear deficiency of McQuilkin, the Examiner sets forth argument that the liner 18, 20 is separate from the jaws 12, 14. This argument, however, is entirely unsupported in McQuilkin and, if true, would render the McQuilkin clip ineffective for its intended purpose.

A careful examination of the entire McQuilkin disclosure points to a conclusion at odds with the Examiner's argument. The liner 18, 20 is mentioned in McQuilkin at:

Col. 1, lines 20 to 21, 37 to 38, 55 to 59;
Col. 2, lines 15 to 21, 52 to 67;
Col. 3, lines 1 to 4, 11, 40 to 41; and
Col. 4, lines 5 to 11, 20, and 39.

In each an every possible configuration, the McQuilkin liner 18, 20 is disclosed as being non-removably fixed to the upper and/or lower jaws 12, 14. This means that even though the liner 18, 20 is of a different material than the jaws 12, 14, it is never

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separate from the jaws 12, 14. The McQuilkin clip would no longer function if the liner 18, 20 separated from the either of the jaws 12, 14. In particular, the single disclosure of how the liner 18, 20 contacts the jaws 12, 14 is found in col. 2, lines 56 to 58 -- "a suitable adhesive is used to fix the lining 18, 20 to the jaws 12, 14." Because the lining 18, 20 is always fixed to the jaws 12, 14, the combination of lining and jaw 12, 18; 14, 20 function as a single integral part.

McQuilkin uses the liner 18, 20 to absolutely ensure that there is no separating distance between the jaws 12, 14 when the jaws 12, 14 are in the closed position. In other words, McQuilkin cannot achieve its intended clipping purpose ("sterilisation" as set forth in every one of the claims 1 to 10) unless the distance between the jaws 12, 14, 18, 20 is equal to ZERO because a positive distance would not allow the clamp to isolate the tissue clamped therebetween. If the distance between:

the two surfaces of the liner 18, 20 (col. 1, lines 37 to 38); or

one surface of the jaws 12 or 14 and one surface of the liner 20 or 18 (col. 2, lines 59 to 67),

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always touch one another, the McQuilkin clip can never be considered to have a "U-shape" structure as set forth and defined in the present application.

McQuilkin discloses a medical clip "suitable for sexual sterilization." See, e.g., Abstract, col. 1, lines 3 to 6, and every one of claims 1 to 10. FIG. 1 illustrates the medical clip in the opened position and FIGS. 2 and 3 illustrate the clip in the closed and closed-and-fastened positions, respectively. Because the clip is to be clamped upon a Fallopian tube or vas deferens to effect occlusion, direct contact between the silicone rubber lining 18, 20 of the jaws 12, 14 is required. In other words, the distance between the jaws 12, 14 is equal to **zero**. Therefore, the McQuilkin retainer cannot have retainer with a length of greater than 2.5 or n "times the distance between the arms when the arms are substantially parallel" as set forth in claims 1, 21, and 22 (see also claim 17).

The McQuilkin jaws 12, 14 are not parallel when in the non-applied (open) position and are parallel only when the clip is in the occluding (closed) position. Accordingly, McQuilkin does not and cannot teach two arms having a "distance between the

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arms when the arms are substantially parallel" to one another as set forth in claims 1, 17, 21, and 22.

Clearly, McQuilkin does not show a surgical clip as recited in claims 1, 21, or 22 of the instant application.

Insofar as claims 1, 21, and 22 are believed to be allowable, and due to the fact that claims 2 to 20 and 23 through 31 ultimately depend upon claims 1 or 22, these claims are believed to be allowable as well.

In item 5 on pages 3 to 4 of the above-identified Office action, claims 17 and 18 have been rejected as being fully anticipated by U.S. 4,430,997 to DiGiovanni et al. (hereinafter "DiGiovanni") under 35 U.S.C. § 102(b).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references.

DiGiovanni discloses a multiple clip applier used to apply clips like those in McQuilkin. See, in particular, FIG. 2A of DiGiovanni. Therefore, all of the arguments with respect to

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McQuilkin are equally applicable to distinguish DiGiovanni from the present invention and are hereby incorporated by reference. It is particularly noted that the DiGiovanni clips are set "to ligate a vessel," are set "about the vessel to be ligated" and/or are "set to ligate the vessel." See DiGiovanni at col. 1, line 15, col. 2, lines 5, 31, and 40, respectively (emphasis added). Ligation requires there to be absolutely no distance between the arms doing the ligation. Thus, the DiGiovanni arms are required have a zero distance when parallel.

Clearly, DiGiovanni does not show a surgical clip as recited in claim 17 of the instant application.

Insofar as claim 17 is believed to be allowable, and due to the fact that claim 18 ultimately depends upon claim 17, this claim is believed to be allowable as well.

In items 6 to 7 on page 4 of the above-identified Office action, claims 1, 3 to 6, 21 to 25, and 28 have been rejected as being fully anticipated by U.S. Patent Publication 2004/0104199 A1 to Chen under 35 U.S.C. § 102(e).

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and,

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therefore, the claims have not been amended to overcome the references.

Chen is a paper clip formed from repeating rectangular coils of metal wire. The Examiner contends that no structure is given to the word "retainer" in claims 1, 21, or 22. Applicants respectfully disagree.

Specifically, claim 1 calls for, *inter alia*, a surgical clip, including:

at least one deformable retainer extending past one end of the arms in a direction, wherein the retainer has a length in the direction of at least approximately n times the distance between the arms when the arms are substantially parallel.

Next claim 21 calls for, *inter alia*, a surgical clip, including:

at least one deformable retainer extending past one end of said arms in a direction, said retainer having a length in said direction equal to a multiple of a distance between said arms, the multiple being greater than 2.5.

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Finally, claim 22 calls for, *inter alia*, a surgical clip,
including:

at least one deformable retainer extending from one of the arms and having a deformable portion, the deformable portion of the retainer having a length of at least approximately n times the distance between the arms when the arms are substantially parallel.

Each of these claims provide structure of the "at least one deformable retainer." Significantly, the structure set forth in the claims is neither disclosed nor suggested by Chen.

In no way does Chen mention or suggest a deformable retainer extending "past one end of the arms" as set forth in claims 1 or 21. Further, Chen does not disclose or suggest a retainer having a deformable portion with the length n times the distance between the arms when the arms are substantially parallel.

Because the Examiner indicates that entirety of the Chen paper clip is deformable, the Examiner is comparing the entire length of this paper clip to the "retainer" of claims 1, 21, and 22.

It is noted that there are first and second arms in the claims,

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as well as a bridge. The retainer extends from one of the arms or past one end of the arms. Such a retainer is not comparable to a portion in the paper clip of Chen.

Finally, it is noted that the final rejection based upon Chen in above-identified January 5, 2005 Office action is, verbatim, the same rejection set forth in the non-final rejection of June 23, 2004. After the non-final rejection, claims 1, 21, and 22 were amended. The final rejection based upon Chen, however, makes no mention of these amendments. It is, therefore, submitted that the failure of the Examiner to address these amendments is an acquiescence to the correctness of applicants' arguments. Thus, the rejection based upon Chen should be withdrawn.

Clearly, Chen does not show a clip as recited in claims 1 or 22 of the instant application.

Insofar as claims 1, 21, and 22 are believed to be allowable, and due to the fact that claims 3, 23, and 28 ultimately depend upon claims 1 or 22, these claims are believed to be allowable as well.

Finally, applicants appreciatively acknowledge the Examiner's statement that claims 8 to 10, 27, and 29 to 31 "would be

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allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." In light of the above, applicants respectfully believe that rewriting of these claims is unnecessary at this time.

In view of the foregoing, reconsideration and allowance of claims 1 to 10 and 17, 18, and 21 to 31 are solicited.

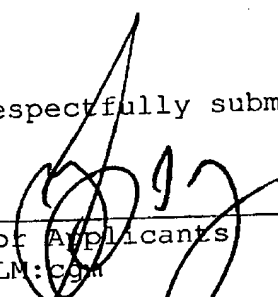
In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out. In the alternative, the entry of the amendment is requested, as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any fees that might be due with respect to
Sections 1.16 and 1.17 to the Deposit Account of Feldman Gale,
P.A., No. 502524.

Respectfully submitted,



For Applicants
GLM:cm

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